

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT TACOMA

UTHERVERSE GAMING LLC,

Plaintiff,

v.

EPIC GAMING, INC.,

Defendant.

Case No. 2:21-cv-00799-RSM-TLF

REDACTED REPORT AND
RECOMMENDATION ON
DEFENDANT'S MOTION TO
AMEND ANSWER AND
COUNTERCLAIMS; AND ORDER
ON MOTION TO EXCLUDE
UNTIMELY INFRINGEMENT
THEORIES

NOTED FOR JULY 28, 2023

A. Motion to Amend Answer and Counterclaims

Defendant Epic Gaming moves for leave to amend the Answer and Counterclaims. Dkt. 236, 240 (sealed). The motion has been fully briefed, and the Court heard oral argument. Dkt 236, 237, 240 (sealed), 253, 254, 255 (sealed), 256 (sealed), 262, 263. For the reasons discussed below, the motion should be granted.

Under Western District of Washington Local Patent Rule 124, "Amendment of . . . the Invalidity Contentions may be made only by order of the Court upon a timely showing of good cause." According to Civil Rule (LCR) 15, a party making a motion to amend a pleading must show how the proposed amended pleading differs from the operative pleading; to identify the proposed changes, the party must indicate amendments "by bracketing or striking through the text to be deleted and underlining or highlighting the text to be added."

1 Epic has submitted its motion in compliance with LCR 15. Dkt. 236-2, at 18-19
2 (Twelfth Affirmative Defense), 20-22 (Thirteenth Affirmative Defense); 26-27 (Second
3 Counterclaim, invalidity contentions, paragraphs 22 through 24); 36-39 (Ninth
4 Counterclaim).

5 Epic moves the Court for an order allowing it to amend the Answer and
6 Counterclaims, based on an assertion of invalidity (Second Counterclaim, Twelfth
7 Affirmative Defense) for failure to accurately name the inventors of the subject matter.
8 See Dkt. 236-2, Epic's proposed Amended Answer to Complaint for Patent Infringement
9 and Counterclaims, at 18-19, 26-27.

10 Epic also moves the Court for an order allowing it to add an affirmative defense
11 and counterclaim of unenforceability of the '071 Patent based on allegedly inequitable
12 conduct. See Dkt. 236-2, Epic's proposed Amended Answer to Complaint for Patent
13 Infringement and Counterclaims, at 20-22 (Thirteenth Affirmative Defense), 36-39 (Ninth
14 Counterclaim).

15 Utherverse objects that the motion is untimely, argues that the proposed
16 amendments should be rejected as unsupported by sufficient factual allegations, and
17 contends that the claim of inequitable conduct was pled with insufficient particularity.
18 Dkt. 253, 255, Plaintiff's Opposition to Defendant's Motion to Amend Answer and
19 Counterclaims, at 7-13.

20 Under Fed. R. Civ. P. 16, if a party moves to amend a pleading after the deadline
21 established in a scheduling order, they must show good cause – i.e., the pretrial
22 schedule could not “reasonably be met despite the diligence of the party seeking the
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1 extension” -- for modifying the scheduling order. *Johnson v. Mammoth Recreations,*
2 *Inc.*, 975 F.2d 604, 609 (9th Cir. 1992).

3 According to Federal Rule of Civil Procedure 15(a), after an initial period for
4 amendment as of right, pleadings may be amended only with the opposing party’s
5 written consent or by leave to the court. Leave to amend should be freely given when
6 justice so requires. Fed. R. Civ. P. 15(a)(2); *Desertrain v. City of Los Angeles*, 754 F.3d
7 1147, 1154 (9th Cir. 2014) (“[T]his policy is to be applied with extreme liberality.”). When
8 a party seeks leave to amend after the responsive pleading has been filed, leave should
9 be granted unless the amendment would cause undue delay, prejudice to an opposing
10 party, is futile, or is sought in bad faith. *Johnson*, 975 F.2d at 607.

11 In this case, the Court should hold that under Fed. R. Civ. P. 15 and 16 the
12 amendment should be allowed. The parties engaged in extensive electronic discovery;
13 after taking depositions, the defendant promptly brought this motion and did not act in a
14 dilatory manner. A party may reasonably confirm factual allegations concerning the
15 inequitable conduct defense by conducting discovery, before amending their pleadings,
16 because Fed. R. Civ. P. 9(b) requires pleading this defense with particularity. *Advanced*
17 *Cardiovascular Sys. v. Scimed Life Sys*, 989 F. Supp. 1237, 1247 (N.D. Cal. 1997).

18 Facts asserted in support of the counterclaims and affirmative defenses alleged
19 in the proposed Amended Answer and Counterclaims (Dkt. 236-1), are accepted as true
20 and construed in the light most favorable to defendant; the pleading must contain
21 sufficient factual matter to “state a claim to relief that is plausible on its face.” *Ashcroft v.*
22 *Iqbal*, 556 U.S. 662, 678 (2008) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570
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1 (2007)). The Court is not required to accept legal conclusions couched as factual
2 allegations. *Ashcroft v. Iqbal*, at 678-679.

3 An amendment is futile if the proposed amendment itself would not survive
4 dismissal. See, e.g., *Gardner v. Martino*, 563 F.3d 981, 992 (9th Cir. 2009) (claim would
5 be futile because First Amendment protected speech could not, as a matter of law, be
6 the basis for a proposed amendment). Under Fed. R. Civ. P. 8(c), the pleading of an
7 affirmative defense must “give [] plaintiff fair notice of the defense.” See *Garcia v.*
8 *Salvation Army*, 918 F.3d 997, 1008 (9th Cir. 2019) (internal citations omitted); see also,
9 *Anticancer Inc. v. Xenogen Corp.*, 248 F.R.D. 278, 282-283 (S.D. Cal. 2007) (applying
10 the *Twombly* standard of plausibility, to patent invalidity and unenforceability claims and
11 affirmative defenses); *TwinStrand Biosciences, Inc. v. Guardant Health, Inc.*, No. 21-
12 1126-GBW-SRF, 2023 WL 1860186 at *3 (D. Delaware 2-9-2023) (a cause of action for
13 patent invalidity under a theory of failure to identify the actual inventors is analyzed
14 under Fed. R. Civ. P. 8, rather than the heightened pleading standard of Fed. R. Civ. P.
15 9(b)).

16 A heightened pleading standard, under Fed. R. Civ. P. 9(b), applies to the
17 allegations that the patent is unenforceable due to inequitable conduct. *Exergen Corp.*
18 *v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1326-1327 (Fed. Cir. 2009). The inequitable
19 conduct defense is “entirely equitable in nature, and thus not an issue for a jury to
20 decide.” *PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315, 1318
21 (Fed. Cir. 2000).

22 Under Rule 201 of the Federal Rules of Evidence, the district court may notice an
23 adjudicative fact if it is “not subject to reasonable dispute”; this test is satisfied if the fact
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1 is “generally known” or “can be accurately and readily determined from sources whose
2 accuracy cannot reasonably be questioned.” Fed. R. Evid. 201(b)(1)-(2). The district
3 court may take judicial notice of matters of public record without converting a motion to
4 dismiss into a motion for summary judgment. *Lee v. City of Los Angeles*, 250 F.3d 668,
5 688-689 (9th Cir. 2001). But the Court may not resolve disputes of fact or take notice of
6 disputed facts that exist in documents that are subject to judicial notice. *Kohja v.*
7 *Orexigen Therapeutics, Inc.*, 899 F.3d 988, 999-1001(9th Cir. 2018).

8 The Court may take judicial notice of patents and documents from file history of a
9 patent, and the Court’s documents, because they are documents within a public record
10 and a court filing. *See Khoja*, 899 F.3d at 1001; *Biggs v. Terhune*, 334 F.3d 910, 915
11 n.3, 916 (9th Cir. 2003) (overruled in part on unrelated grounds by *Hayward v. Marshall*,
12 603 F.3d 546, 555 (9th Cir. 2010)); *Audionics System, Inc. v. AAMP of Florida, Inc.*, No.
13 CV 12-10763 MMM (JEMx), 2013 WL 12129652 at *1 - *8 (C.D. Cal. 11-19-2013)
14 (analyzing case law concerning whether an affirmative defense has been properly pled,
15 and whether the affirmative defense of inequitable conduct -- with respect to failure to
16 accurately identify the inventors -- should be stricken for failure to state a claim and
17 whether amendment should be allowed, in a patent case).

18 1. Failure to list inventor.

19 The law of inventorship “requires only that a co-inventor make a contribution to
20 the conception of the subject matter of the claim.” *Eli Lilly & Co. v. Aradigm Corp.*, 376
21 F.3d 1352, 1361-1362 (Fed. Cir. 2004). Inventorship is a question of law that is
22 premised on underlying questions of fact. *Id.* at 1362-1363. The contribution to the
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1 conception of the invention must have been a contribution “in some significant manner”.
2 *Plastipak Packaging, Inc. v. Premium Waters, Inc.*, 55 F.4th 1332, 1340 (Fed. Cir. 2022).

3 The Federal Court Bar Association’s Jury Instructions for Patent Cases set forth
4 the following elements the defendant must prove to successfully establish invalidity. The
5 jury considers whether the patent “fails to meet the requirement that all of the actual
6 inventors, and only the actual inventors, be named as inventors in the patent.” FCBA
7 Model Patent Jury Instructions, B.4.3d, model instruction on inventorship, at 52 (May
8 2020). “To be an inventor one must make a significant contribution to the conception of
9 at least one of the claims of the patent [even if that claim has not been alleged to be
10 infringed]. Whether the contribution is significant in quality is measured against the
11 scope of the full invention.” *Id.*

12 “Merely helping with experimentation, by carrying out the inventor’s instructions,
13 also does not make someone an inventor. What is required is some significant
14 contribution to the idea claimed. Persons may be inventors even if they do not make the
15 same type or amount of contribution, and even if they do not contribute to the subject
16 matter of each claim of the patent. Persons may be joint or co-inventors even though
17 they do not physically work together, but they must have some open line of
18 communication during or at approximately the time of their inventive effort.” *Id.*

19 The term “conception” means “[t]he complete mental part of the inventive act
20 when the inventor forms a definite and permanent idea of an invention someone else
21 could make without undue experimentation. Conception must be capable of proof, as by
22 drawings, disclosure to another, etc.” *Id.*, part C., Glossary, at 76.

1 The term “claim” means “[e]ach claim of a patent is a concise, formal definition of
2 an invention and appears at the end of the specification in a separately numbered
3 paragraph. In concept, a patent claim marks the boundaries of the patent in the same
4 way that a legal description in a deed specifies the boundaries of land, i.e., similar to a
5 landowner who can prevent others from trespassing on the bounded property, the
6 inventor can prevent others from using what is claimed. . .” Id.

7 The Court should hold that defendant has pled sufficient facts to put plaintiff on
8 notice of the claim of invalidity based on failure to identify inventors. The defendant has
9 asserted that Robert Flesch and William Andrew were involved with and made
10 significant contributions to the claims, creative work concerning functions and unique
11 features of the ‘071 Patent, that are material to the dispute in this case. These
12 assertions of fact are not phrased as legal conclusions – defendant has set forth
13 sufficient assertions of fact to assert an invalidity claim based on failure to identify
14 inventors.

15 The defendant’s proposed amended pleading asserts that “Flesch and Andrew
16 conceived of and developed at least the ‘instancing’ functionality that the ‘071 patent
17 attempts to claim as ‘modeling . . . a plurality of parallel dimensions in a computer
18 memory,’ that allows avatars to “populate different ones of the parallel dimensions.” Dkt.
19 236-1 at 18. Defendants allege that, before the ‘071 Patent application was filed in 2009
20 by Gary and Brian Shuster, Flesch and Andrew had previously “conceived of and
21 developed” a codebase as a product of their Prototerra company. Defendants allege
22 that the Shusters omitted Flesch and Andrew from the list of inventors for the ‘071
23 Patent, even though they hired Flesch and Andrew to work on the codebase that later
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1 became the '071 Patent, Flesch and Andrew were listed as inventors on the precursor
2 American and Canadian patent application(s), and they knew the codebase of
3 Prototerra was a major contribution to the '071 Patent. *Id.* at 19.

4 Because the Court is considering the motion to amend under a “fair notice” and
5 “plausibility” standard, *Ashcroft v. Iqbal*, at 678, plaintiff’s assertions about evidence in
6 the Court’s adjudicative record – arguing futility by disputing the defendant’s allegations
7 of facts concerning invalidity of the '071 Patent for failure to identify inventors, and
8 arguing the merits based on disputes of fact -- would not be appropriate to the inquiry.
9 *Kohja v. Orexigen Therapeutics, Inc.*, 899 F.3d 988, 999-1001 (9th Cir. 2018).

10 To analyze whether any amendment would be futile, the Court accepts the
11 assertions of fact as true for purposes of the analysis under Fed. R. Civ. P. 12(b)(6).
12 *Ashcroft v. Iqbal*, at 678. Invalidity must be proved by clear and convincing evidence –
13 the jury “must be left with a clear conviction that the claim is invalid.” FCBA Model
14 Patent Jury Instructions, B.4.1, model instruction on invalidity burden of proof, at 37
15 (May 2020); citing, *Microsoft Corp. v i4i Limited Partnership*, 564 U.S. 91 (2011).
16 Allegations in a counterclaim “must plausibly suggest an entitlement to relief” and must
17 contain “sufficient allegations of underlying facts to give fair notice and to enable the
18 opposing party to defend itself effectively.” *Starr v. Baca*, 652 F.3d 1202, 1216 (9th Cir.
19 2011). In this case, Epic has alleged more than legal conclusions, has not used
20 boilerplate language, and has provided sufficient factual assertions to give Utherverse
21 fair notice of the basis for the claims that every inventor was not listed in the '071
22 Patent.

1 2. Unenforceable patent, based on allegations of inequitable conduct.

2 To state a claim of inequitable conduct, the party must plead, under Fed. R. Civ.
3 P. 9, with particularity the “the specific who, what, when, where, and how of the material
4 misrepresentation or omission committed before the PTO.” *Exergen Corp. V. Wal-Mart*
5 *Stores, Inc.*, 575 F.3d 1312, 1326-1328 (Fed. Cir. 2009).

6 The party must plead the facts in detail and describe what the person allegedly
7 did that was inequitable, and how the person allegedly perpetrated the inequitable
8 conduct. *Id.*, at 1327. The party asserting this defense must show “the patentee acted
9 with the specific intent to deceive the PTO.” *Therasense, Inc. v. Becton, Dickinson and*
10 *Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011) (en banc).

11 The party asserting the defense “must prove by clear and convincing evidence
12 that the applicant knew of the reference, knew that it was material, and made a
13 deliberate decision to withhold it.” *Id.* Materiality is separate from specific intent; failure
14 to disclose an inventor is material information because the patent examiners are
15 required to reject applications if improper inventorship is found. *PerSeptive Biosystems,*
16 *Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315, 1321-1322 (Fed. Cir. 2000). This
17 equitable defense “expands discovery into corporate practices before patent filing and
18 disqualifies the prosecuting attorney from the patentee’s litigation team.” *Therasense*,
19 649 F.3d at 1288.

20 Allegations of specific deceptive intent may be alleged generally and may be
21 based on circumstantial evidence. *Exergen*, 575 F.3d at 1327, 1328, n.5. An individual
22 who no longer has ownership rights is not disqualified as a possible inventor;
23 inventorship and ownership are distinct. FCBA Model Patent Jury Instructions, B.4.3d,

1 model instruction on inventorship, at 52 (May 2020); *DeCurtis LLC v. Carnival*
2 *Corporation*, No. 20-22945-Civ-SCOLA/TORRES, 2021 WL 7539904, at *14, Report
3 and Recommendation adopted as modified, 2021 WWL 1540518 (April 20, 2021).

4 Allegations of inequitable conduct will survive analysis for futility, under Fed. R.
5 Civ. P. 12(b)(6), only if the facts asserted allow the court to make a reasonable
6 inference that a particular person knew of invalidating information being withheld from
7 the PTO, with specific intent to deceive the PTO. *Delano Farms Co. v. California Table*
8 *Grape Com'n*, 655 F.3d 1337, 1350 (Fed. Cir. 2011). Inequitable conduct is an
9 allegation that, if found by a jury to be proved as to any single claim in the patent, may
10 result in a remedy that renders the entire patent unenforceable. *Therasense, Inc.*, 649
11 F.3d at 1288. Moreover, prevailing on the defense of inequitable conduct may make a
12 case “exceptional” and may potentially lead to an award of attorneys’ fees under 35
13 U.S.C. § 285. *Id.*, at 1289.

14 In this case, Epic asserts sufficient facts to state a claim under Fed. R. Civ. P. 9
15 regarding whether “the applicant knew of the [information about inventorship], knew that
16 it was material, and made a deliberate decision to withhold it.” *Therasense, Inc.*, 649
17 F.3d at 1290. Materiality of the information has been plausibly alleged in the amended
18 pleading. Dkt. 236-2 at 26-27, ¶¶ 22-24; at 37, ¶¶ 71-73.

19 The assertions of fact regarding specific intent to deceive also meet the
20 plausibility standard. The assertions describe circumstances where Mr. Flesch and Mr.
21 Andrew were initially included as inventors in applications that eventually led to the ‘071
22 patent, but in later iterations they were not named as inventors. Dkt. 236-2 at 26-27, ¶¶
23 22-24; at 37, ¶¶ 71-73. The defendant also alleges a series of events regarding the

1 plaintiff's conduct toward Mr. Flesch and Mr. Andrew suggesting that plaintiff may have
2 been less than forthcoming about inventorship and what they contributed to the patent.
3 *Id.*

4 In the context of a summary judgment motion, the Court would consider whether
5 specific intent to deceive was the single most reasonable inference. See *Ohio Willow*
6 *Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1351 (Fed. Cir. 2013) ("specific intent to
7 commit inequitable conduct may be inferred from indirect and circumstantial evidence. .
8 .. [but] deceptive intent must be 'the single most reasonable inference drawn from the
9 evidence' (internal citations omitted)). Yet, at this stage of the litigation, the Court
10 should apply the plausibility standard and hold that the defendants have alleged
11 sufficient facts to allow the amended pleading to go forward. *Delano Farms Co. v.*
12 *California Table Grape Com'n*, 655 F.3d 1337, 1350 (Fed. Cir. 2011); see also, *Maquet*
13 *Cardiovascular LLC v. Abiomed, Inc.*, 627 F. Supp.3d 54, 67 (D. Mass. 2022) (allegation
14 that a co-inventor was listed on an application for a patent that eventually led to the
15 patents at issue, was plausible -- to show the allegedly missing inventor "appears to
16 have provided essential support" and the patentee "was obliged to disclose their
17 contributions to the PTO").

18 **B. Motion To Exclude Untimely Infringement Theories**

19 Defendant moves the Court to exclude infringement theories that have allegedly
20 been untimely asserted. Dkt. 231, 232; see also, Dkt. 235 (sealed). The motion has
21 been fully briefed. Dkt. 258, 260 (sealed), 261 (sealed), 267. For the reasons discussed
22 below, defendant's motion is denied.

1 The plaintiff's infringement contentions (ICs) must be specific enough "to provide
2 reasonable notice to the defendant why the plaintiff believes it has a 'reasonable chance
3 of proving infringement'". *Shared Memory Graphics LLC v. Apple, Inc.*, 812 F. Supp. 2d
4 1022, 1025 (N.D. Cal. 2010) (*quoting, View Ing'g, Inc. v Robotic Vision Sys., Inc.*, 208
5 F.3d 981, 986 (Fed. Cir. 2000). The ICs "do not need to include direct proof or direct
6 evidence of infringement." *AntiCancer, Inc. v. Pfizer, Inc.*, 769 F.3d 1323, 1338 (Fed.
7 Cir. 2014).

8 In this case, the defendant argues that plaintiff is asserting a new theory for
9 infringement contentions, because plaintiff's expert, Dr. Rosenberg, discusses the
10 "lobby" where a player begins their gaming experience. Dkt. 231 at 8-9. Defendant
11 seeks to exclude the following pages, sections, and paragraphs of Dr. Rosenberg's
12 expert report:

13 Dkt. 232, Decl. of Matthaeus Martino-Weinhardt, Ex. 1, Expert Report of Craig
14 Rosenberg, Ph.D., (redacted); Dkt. 235 (sealed), at: pp. 6-7, Section 11.6, p. 14,
15 Section 12.2 (last paragraph); p. 15, Section 12.3 (last paragraph); pp. 17-18, Section
16 12.4 (last paragraph); p.19, Section 12.5 (last paragraph); pp. 20-21, Section 12.6 (last
17 paragraph); p. 23. Section 13.1 (last paragraph); p. 25, Section 13.3 (last paragraph);
18 pp. 27-28, Section 13.4 (last paragraph); p. 29, section 13.5 (last paragraph); p. 32,
19 Section 14.2 (last paragraph); p. 34, Section 14.3 (last paragraph); p. 36, Section 14.4
20 (last paragraph); p. 38 (Section 14.5 (last paragraph); p. 41, Section 15.2 (last
21 paragraph); p. 43, Section 15.3 (last paragraph); p. 45, Section 15.4 (last paragraph); p.
22 46, Section 15.5 (last paragraph); p. 48, Section 16.5 (first sentence of the first full
23 paragraph on this page); pp. 50-51, Section 16.5 (last half of final sentence starting on
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1 page 50 – sentence concludes on page 51); p. 53, Section 16.5.1 (paragraph labeled
2 (3)); p. 56, Section 17.5 (first sentence of second full paragraph); p. 59, Section 17.5,
3 second full paragraph, last half of the sentence); p. 64, section 17.5 (paragraph labeled
4 (3)).

5 Plaintiff asserts their theory is not altered. Instead, according to plaintiff, their
6 expert is discussing evidence that supports an existing theory – the lobby is part of how
7 the matchmaking function works and it is therefore connected to the matchmaking
8 function. Plaintiff contends this is not a new theory, because the plaintiff has
9 consistently identified the matchmaking function as a theory of infringement. Dkt. 258,
10 Plaintiff’s Response, at 10.

11 The Court reviewed the excerpts of the expert report, Dkt. 232, Decl. of
12 Matthaeus Martino-Weinhardt, Dkt. 232-1, Expert Report of Craig Rosenberg, Ph.D.,
13 (redacted); Dkt. 235 (sealed). The Court also reviewed (regarding the ‘071 and ‘605
14 patents) the plaintiff’s Complaint (Dkt. 1, Complaint at 22-28, 37-48, Dkt. 1-4, 1-7);
15 infringement contentions (Dkt. 232-3, 232-4, 232-5, and Dkt. 235-2 (sealed)); the
16 Court’s Order re: Claims Construction, and Order Denying Plaintiff’s Motion for
17 Reconsideration (Dkt. 133, 146).

18 The Order re: Claims Construction does not address the lobby specifically, but it
19 does refer to “space” and “common space”. Dkt. 133 at 11-12. The Court found that the
20 parties agreed the term “space” is an area or portion of a virtual environment. Dkt. 133
21 at 11, ll. 16-18. The Court adopted Utherverse’s construction of the term “common
22 space”, and determined the intrinsic record supported that construction: “[in] an
23 embodiment of the inventions, a defined area or portion of multiple dimensions may be
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1 visible to, and/or interact with, other parts or members of the dimensions. '071:5:24-26'
2 The specification otherwise clearly provides the basis for the Utherverse Gaming
3 construction." *Id.* at 11; see also, Dkt. 76, Utherverse brief re: claims construction, and
4 "common space" term, at 13-15.

5 For example, the expert report of Dr. Rosenberg, discussing Claim 1, makes
6 reference to [REDACTED]

7 [REDACTED]
8 [REDACTED] Dkt. 235, at 7, Section 11.6. With respect to Claim 8, and the "common space"
9 that is part of Claim 8, Dr. Rosenberg's report refers to [REDACTED]

10 [REDACTED]
11 [REDACTED]
12 [REDACTED]. See e.g., Dkt. 235, Section 12.5, pp. 18-19. [REDACTED]

13 [REDACTED]
14 [REDACTED] And, the "space" or "common space" as discussed by the
15 Court's Claim Construction Order, Dkt. 133 at 11-12, is consistent with Dr. Rosenberg's
16 description of the lobby.

17 Therefore, the Court finds the factual record does not support defendant's
18 argument that plaintiff's expert is inserting a new theory. The portions of plaintiff's expert
19 report that have been identified by the defendant's motion will not be stricken. These
20 paragraphs and sentences merely identify the way the lobby connects with the
21 matchmaking function and there is no indication that the expert witness report is being
22 used as a vehicle to add a new contention theory. As plaintiff argues in the response,
23 Dkt. 258, 260 (sealed) at 6, the infringement contentions identified the matchmaking
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1 function (e.g., Dkt. 232-3 at 21, 26, 38-39, 60; Dkt. 232-4 at 21-22, 35-36, 39; Dkt. 235-5
2 (sealed) at 8-10, 40, 50-52, 80, 83-86, 97-98, 109-114, 144, 149, 151-154, 168, 177-
3 180) and through the discovery depositions of individuals with technical knowledge the
4 plaintiff acquired more clarity about the connection between the lobby and the
5 matchmaking function. See, e.g., Dkt. 261-6, Sealed Deposition of Mark Imbriaco, at 3-
6 5. Therefore, the information included in the expert report reflects the infringement
7 contentions, and clarity provided by additional discovery.

8 **C. Conclusion**

9 The Court recommends that defendant's motion for leave to amend should be
10 GRANTED.

11 The Court orders defendant's motion to exclude untimely infringement theories is
12 DENIED.

13 Pursuant to 28 U.S.C. § 636(b)(1) and Fed. R. Civ. P. 72(b), the parties shall
14 have fourteen (14) days from service of this report to file written objections to the report
15 and recommendation on defendant's motion to amend the answer and counterclaims.
16 See *also* Fed. R. Civ. P. 6. Any objections to the Magistrate Judge's non-dispositive
17 order on the motion to exclude untimely infringement theories are also due by July 28,
18 2023. See Fed. R. Civ. P. 72(a).

19 Failure to file objections will result in a waiver of those objections for purposes of
20 *de novo* review by the district judge, see 28 U.S.C. § 636(b)(1)(C), and can result in a
21 waiver of those objections for purposes of appeal. See *Thomas v. Arn*, 474 U.S. 140,
22 142 (1985); *Miranda v. Anchondo*, 684 F.3d 844, 848 (9th Cir. 2012) (citations omitted).

1 Accommodating the time limit imposed by Fed. R. Civ. P. 72(b), the Clerk is directed to
2 set the matter for consideration on July 28, 2023, as noted in the caption.

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4 The Clerk is directed to send a copy of this order to each party.

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6 Dated this 10th day of July, 2023.

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8 Theresa L. Fricke
9 United States Magistrate Judge
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